

## **REMARKS**

### **I. Status of Claims**

Claims 1-20 are pending with claims 1, 12 and 18 being independent. Applicants thank Examiner for indicating that claims 1-11 are allowed.

### **II. Rejections under 35 U.S.C. §103(a) as being obvious over JELINEK et al. (US 5,390,337 A)**

The Examiner has rejected claims 12-20 under 35 U.S.C. §103(a) as being obvious over JELINEK et al. (US 5,390,337 A). However, rather than presenting a detailed review of the claim elements as required to maintain the rejection under 35 U.S.C. §103(a), claims 12-20 have been summarily rejected based upon JELINEK et al. Accordingly, Applicants respectfully request that if the Examiner maintains or presents new rejections, that the rejections include a detailed review of the claim elements for each of the rejected claims. Specifically, it is requested that a rejection for each claim include an identification of which prior art references teach which limitations and where in the corresponding prior art references the limitations are taught. Further, should the Examiner maintain the rejection, the Examiner is respectfully requested to address each of the below arguments in detail.

Applicant's respectfully request reconsideration of the rejections because the Examiner has failed to establish a *prima facie* case of obviousness for the rejection. A *prima facie* case of obviousness requires three basic criteria to be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. At the least, the Examiner has failed to meet the first and third requirements by not providing a prior art reference (or references when combined) that teach or suggests all the claim limitations and by not providing proper motivation.

In the Examiner's rejection, the Examiner indicated that JELINEK et al. "teaches a combination surge and duplex filter that has a high pass filter section and low pass filter section." The Examiner goes on to indicate that "the arrangement would direct low frequency surge events

to the low pass filter and would direct high frequency surge events to the high pass filter.” It is noted that the Examiner has not identified which limitations are taught by JELINEK et al. and where within JELINEK et al. the limitations are taught. Nevertheless, the Examiner goes on to admit that JELINEK et al. fails to teach each and every feature, and fails to identify which limitations of which claims are not taught by JELINEK et al. Instead, the Examiner merely indicates that JELINEK et al. “differs from the claims by not reciting the common place elements that would be part of a surge protection filter arrangement.” Further, the Examiner has failed to provide a secondary prior art reference that teaches or suggests that which the Examiner admits JELINEK et al. does not teach. It is never appropriate to rely solely on “common knowledge” in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *In re Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. Therefore, since the Examiner has not provided a prior art reference (or references when combined) that teach or suggest all the claim limitations the Examiner has failed to establish a *prima facie* case of obviousness for the rejection. Accordingly, withdrawal of the rejection based on JELINEK et al is hereby requested.

However, if in not providing a secondary reference the Examiner was attempting to take an Examiner’s Official Notice (EON), Applicants respectfully argue that the EON is not adequate and traverse the EON. The Examiner is referred to section 2144.03 of the MPEP. “Official notice without documentary evidence to support an Examiner's conclusion is permissible only in some circumstances.” “If such notice is taken, the basis for such reasoning must be set forth explicitly. The Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241.” Here, the Examiner has merely made a conclusion of common knowledge and has not provided specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. Therefore the EON is inadequate for the above reason and the Examiner is respectfully requested to provide documentary evidence to support the Examiner's conclusion.

As motivation, the Examiner indicates that “the formation of surge protection filters of conventional design and configuration is well known in the art, with such filter formation

understood to fail to meet the requirements of an inventive step.” It is the duty of the Examiner to explain why the combination of the teachings is proper. Ex parte Skinner, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). Here, the Examiner has merely made a conclusionary statement that the combination of JELINEK et al. and surge protection filters of conventional design is well known and has not provided some suggestion or motivation as to why one of ordinary skill in the art would modify JELINEK et al. in view of surge protection filters of conventional design. Therefore, for at least the above reason, the Examiner has failed to establish a *prima facie* case of obviousness for the rejection. Accordingly, Applicants respectfully request that if the Examiner maintains or presents new rejections, that the rejections include proper motivation. Further, withdrawal of the rejection based on JELINEK et al is once again hereby requested.

Applicant’s further request reconsideration of the rejections because JELINEK et al., neither explicitly nor implicitly, discloses, teaches, suggest nor renders obvious each and every feature of the claims. JELINEK et al.’s teaching deals with a pair of communications paths wherein a first communication path is a high frequency line and a second communication path is a low frequency line. The first and second communication paths are coupled to a single input and output. In order to facilitate the first and second communication paths from common inputs and outputs, high pass and low pass filters are used at the endpoint of the first and second communication paths respectively. Additionally, only the first communication path (high frequency line) includes a surge filter. By contrast independent claim 12 recites:

A surge protection device having a high frequency line, a gas arrestor and a first decoupling filter disposed between an input terminal and an output terminal, said surge protection device being adapted to protect a communication device from a high voltage, high frequency signal and from a high voltage low frequency signal, said surge protection device, comprising:

a low frequency line, adapted to divert a high voltage, high frequency signal from said high frequency line when said high voltage, high frequency signal is applied to said input terminal; and  
a second decoupling filter, adapted to filter said high voltage, low frequency signal from said low frequency line.

JELINEK et al. fails to teach or suggest a low frequency line, adapted to divert a high voltage, high frequency signal from said high frequency line when said high voltage, high frequency signal is applied to said input terminal. In JELINEK et al. the low frequency line and the high frequency line do not effect each other because they are independent from one another. Accordingly, JELINEK et al. **cannot** teach or suggest a low frequency line, adapted to divert a high voltage, high frequency signal from said high frequency line when said high voltage, high frequency signal is applied to said input terminal. Likewise, JELINEK et al. fails to teach or suggest a second decoupling filter, adapted to filter said high voltage, low frequency signal from said low frequency line. In JELINEK et al. a low frequency signal is not filtered in the low frequency line. Accordingly, JELINEK et al. **cannot** teach or suggest a second decoupling filter, adapted to filter said high voltage, low frequency signal from said low frequency line. Still further, JELINEK et al. fails to disclose a gas arrestor. Therefore, claim 12 is allowable over JELINEK et al. for the reasons given above and withdrawal of the rejection based on JELINEK et al is hereby requested. Moreover, dependent claims 12-17 are allowable for the reasons given above by virtue of their dependence on independent claim 12.

With respect to independent claim 18, the claim recites:

A method of providing surge protection for a  
communication system, said method comprising:  
detecting a presence of an impulse signal;  
providing said impulse signal to a low frequency line if said  
impulse signal comprises a high voltage, low frequency signal; and  
providing said impulse signal to a high frequency line if said  
impulse signal comprises a high voltage, high frequency signal.

JELINEK et al. fails to teach or suggest detecting a presence of an impulse signal; providing said impulse signal to a low frequency line if said impulse signal comprises a high voltage, low frequency signal; and providing said impulse signal to a high frequency line if said impulse signal comprises a high voltage, high frequency signal. Applicant's have reviewed the entirety of JELINEK et al. and do not see how any portion of JELINEK et al. could be interpreted as teaching *detecting a presence of an impulse signal*. Likewise, it is not seen how any portion of JELINEK et al. could be interpreted as teaching *providing said impulse signal to a*

*low frequency line if said impulse signal comprises a high voltage, low frequency signal; and providing said impulse signal to a high frequency line if said impulse signal comprises a high voltage, high frequency signal. Should the Examiner maintain the rejection, the Examiner is respectfully requested to articulate in detail how SHIN is being interpreted as teaching each and every element of detecting a presence of an impulse signal; providing said impulse signal to a low frequency line if said impulse signal comprises a high voltage, low frequency signal; and providing said impulse signal to a high frequency line if said impulse signal comprises a high voltage, high frequency signal. Therefore, claim 18 is allowable over JELINEK et al. for the reasons given above and withdrawal of the rejection based on JELINEK et al is hereby requested. Moreover, dependent claims 19 and 20 are allowable for the reasons given above by virtue of their dependence on independent claim 18.*

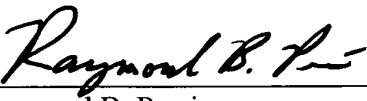
Appl. No. 10/712,774  
Amdt. dated November 9, 2006  
Reply to Office Action of July 12, 2006

### III. Conclusion

In view of the above, it is believed that the above-identified application is in condition for allowance, and notice to that effect is respectfully requested. Should the Examiner have any questions, the Examiner is encouraged to contact the undersigned at the telephone number indicated below.

Respectfully submitted,

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